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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,003	11/30/2001	Craig A. Rosen	PA003P1	7261
22195	7590	12/19/2003	EXAMINER	
HUMAN GENOME SCIENCES INC 9410 KEY WEST AVENUE ROCKVILLE, MD 20850			CHAKRABARTI, ARUN K	
			ART UNIT	PAPER NUMBER
			1634	
DATE MAILED: 12/19/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/997,003**

Applicant(s)  
**Rosen**

Examiner  
**Arun Chakrabarti**

Art Unit  
**1634**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 20, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2 and 25-40 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 25-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1003 6) ☒ Other: Detailed Action

Art Unit: 1634

## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of Group II in Paper No. 1103 is acknowledged. Applicant has canceled claims 1 and 3-24 without prejudice or disclaimer and added new claims 25-40. The traversal is on the ground(s) that the examination of claims of Groups I and III-VI would pose no undue burden. Argument regarding examination of claims of all other groups are moot in view of the amendment. However, claim 2 belonging to Group I is still pending. This claim is also hereby being examined.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is rejected because it is dependent on a canceled and therefore non-existent claim

1. In absence of claim 1, it is not clear what nucleic acid molecule is claimed in claim 2. The metes and bounds of the claims are vague and indefinite.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1634

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.


5. Claims 25-40 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The SEQ ID NO; or the exact nucleotide sequence of HTELE03 cDNA contained in ATCC deposit No. PTA-498 critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Although no prior art discloses amino acid residues 1 to 63 of SEQ ID NO: 41 and has been found unique, it is not disclosed whether nucleotide sequence of HTELE03 cDNA contained in ATCC deposit No. PTA-498 is identical to the sequence encoding amino acid residues 1 to 63 of SEQ ID NO: 41 or if it is different, what is the percent of similarity. ATCC deposit No. PTA-498 is not a database and therefore was unsearchable. In absence of a SEQ ID Number or Genbak Accession Number for ATCC deposit No. PTA-498, claims 25-40 do not comply with sequence rule of USPTO. Moreover, this is improper incorporation by reference, as the essential elements of the claimed invention i.e., the exact nucleotide sequence of HTELE03 cDNA contained in ATCC deposit No. PTA-498 is not disclosed either in the claim or in the specification.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun Chakrabarti, Ph.D., whose telephone number is (703)

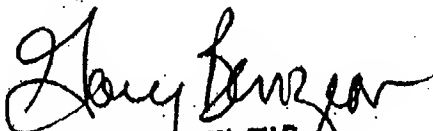
Art Unit: 1634

306-5818. This phone number will be changed to (571)272-0740 on and from January 14, 2004. The examiner can normally be reached on 7:00 AM-4:30 PM from Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703) 308-1119. The fax phone number for this Group is (703) 746-4979. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group LIE Chantae Dessau whose telephone number is (703) 605-1237.

  
**ARUNK. CHAKRABARTI**  
**PATENT EXAMINER**  
Arun Chakrabarti,

Patent Examiner,

December 2, 2003

  
**GARY BENZION, PH.D**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**